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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/679,659	10/06/2003	Tae-Kyung Kim	02-ASD-270 (EM)	4114
200	7590	10/20/2006	EXAMINER	
EATON CORPORATION EATON CENTER 1111 SUPERIOR AVENUE CLEVELAND, OH 44114			LEE, EDMUND H	
			ART UNIT	PAPER NUMBER
			1732	

DATE MAILED: 10/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/679,659

Applicant(s)

KIM, TAE-KYUNG

Examiner

EDMUND H. LEE

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant should note that the examiner of record has been changed from Angela Ortiz to Edmund Lee.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art as set forth in the instant specification at paragraph 0003 in view of Heintz (USPN 1975149). In regard to claim 1, the admitted prior art teaches the basic claimed process including a providing a seal between separate gaskets/structural members -- this teaching inherent implies that a sealant is disposed within a pocket created between the separate gaskets, and the sealant is cured to form a seal. The admitted prior art, however, does not teach disposing a first gasket on a surface of a first member; disposing a second gasket on a surface adjacent an edge of the first gasket; disposing a second member to be sealed over the first and second gasket; and compressing the gasket to disperse the sealant and fill the pocket. Heintz teaches a method of creating a seal in order to prevent fluid from escaping from the joint (pg 1, lns 48-100; figs 1-4); disposing the first edge of the opening on a surface of a first member (pg 1, lns 48-100; figs 1-4); disposing a second edge of the opening on a surface

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adjacent the first edge (pg 1, lns 48-100; figs 1-4); disposing a second member to be sealed over the first and second edges (pg 1, lns 48-100; figs 1-4); and compressing the edges to disperse the sealant and fill the pocket (pg 1, lns 48-100; figs 1-4). The admitted prior art and Heintz are combinable because they are analogous with respect to forming a seal to form a sealed joint. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to form the seal of the admitted prior art by the process of Heintz in order to efficiently form a sealed joint. In regard to claim 2, such material is taught by the combination of the admitted prior art and Heintz since Heintz teaches the use of a pellet of uncured/unvulcanized rubber (pg 1, lns 48-100; figs 1-4). In regard to claim 3, the state of a molding material is a mere obvious matter of choice dependent on material availability and of little patentable consequence to the claimed process since it is not a manipulative feature or step of the claimed process. Further, semi-liquid molding material is well-known in the molding art. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a semi-liquid material in the process of the admitted prior art (modified) in order to reduce molding costs and time. In regard to claim 4, the use of a specific molding material is a mere obvious matter of choice dependent on material availability and desired final product and of little patentable consequence to the claimed process since it is not a manipulative feature or step of the claimed process. Further, silicone gel is well-known in the molding art. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use silicone gel in the process of the admitted prior art (modified) in order to produce a diverse sealed joint. In

regard to claim 5, such is taught by the combination of the admitted prior art and Heintz since Heintz teaches curing the sealant by heat (pg 1, lns 48-100; figs 1-4). In regard to claims 6 and 7, the specific shape of the pocket is a mere obvious matter of choice dependent on the desired final product and material availability and of little patentable consequence to the claimed process since it is not a manipulative feature or step of the claimed process. Further, the specific pocket shape and the complete filling of the shape with molding material are well-known in the molding art. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to shape the pocket of the admitted prior art to be "V" shaped and to fill the entire pocket with the sealant in order to increase contact surface for better bonding. In regard to claim 8, such use of material having different stiffness is taught by the admitted prior art.

4. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art as set forth in the instant specification at paragraph 0003 in view of Haberstump (USPN 2392734). In regard to claim 1, the admitted prior art teaches the basic claimed process including a providing a seal between separate gaskets/structural members -- this teaching inherent implies that a sealant is disposed within a pocket created between the separate gaskets, and the sealant is cured to form a seal. The admitted prior art also teaches that the prior art process of forming a seal does not allow for materials of different stiffness or compressibility to be joined. The admitted prior art, however, does not teach disposing a first gasket on a surface of a first member; disposing a second gasket on a surface adjacent an edge of the first gasket; disposing

a second member to be sealed over the first and second gasket; and compressing the gasket to disperse the sealant and fill the pocket. Haberstump teaches a method of creating a seal in order to join adjacent edges of various materials including metal and plastic (pg 1, col 2, lns 1-54; figs 6-13); disposing an edge of the first material on a surface of a first member (pg 1, col 2, lns 1-54; figs 6-13); disposing an edge of the second material on a surface adjacent the first material (pg 1, col 2, lns 1-54; figs 6-13); disposing a second member to be sealed over the first and second materials (pg 1, col 2, lns 1-54; figs 6-13); and compressing the materials to disperse the sealant and fill the pocket (pg 1, lns 48-100; figs 1-4). The admitted prior art and Haberstump are combinable because they are analogous with respect to forming a seal to form a sealed joint. Further, Haberstump teaches that his process can be used to form a joint between metal and plastics--this teaching addresses the problem mentioned by the admitted prior art. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to form the seal of the admitted prior art by the process of Haberstump in order to efficiently form a sealed joint between differing materials. In regard to claim 2, such material is taught by the combination of the admitted prior art and Heintz since Heintz teaches the use of a bonding material having various desired shapes (pg 3, col 1, lns 25-59). In regard to claim 3, the state of a molding material is a mere obvious matter of choice dependent on material availability and of little patentable consequence to the claimed process since it is not a manipulative feature or step of the claimed process. Further, semi-liquid molding material is well-known in the molding art. Thus, it would have been obvious to one of ordinary skill in the art at the time the

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invention was made to use a semi-liquid material in the process of the admitted prior art (modified) in order to reduce molding costs and time. In regard to claim 4, the use of a specific molding material is a mere obvious matter of choice dependent on material availability and desired final product and of little patentable consequence to the claimed process since it is not a manipulative feature or step of the claimed process. Further, silicone gel is well-known in the molding art. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use silicone gel in the process of the admitted prior art (modified) in order to produce a diverse sealed joint. In regard to claim 5, such is taught by the combination of the admitted prior art and Haberstump since Haberstump teaches using heat to form the seal (pg 1, col 2, lns 1-54; figs 6-13). In regard to claims 6 and 7, the specific shape and flow is taught by the combination of the admitted prior art and Haberstump since Haberstump teaches materials arranged to form the "V" shape pocket and bonding material that flows into the narrow channels of the pocket (figs 8-10). In regard to claim 8, such use of material having different stiffness is taught by the admitted prior art.

5. Applicant's arguments, see pgs 4-6, filed 7/24/06, with respect to the rejection(s) of claims 1-8 under 35 USC 103a have been fully considered and are persuasive.

Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of the admitted prior, Heintz, and Haberstump.

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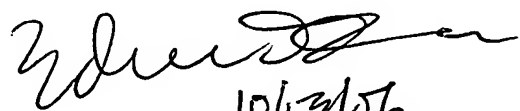
6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following US patents show the state of the art: 4183778; 1470442; 2571259; 4514125; and 3756635 .

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDMUND H. LEE whose telephone number is 571.272.1204. The examiner can normally be reached on MONDAY-THURSDAY FROM 9AM-4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson can be reached on 571.272.1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

EDMUND H. LEE
Primary Examiner
Art Unit 1732



10/13/06